

Appl. No. 10/780,267
Docket No. 9176R
Amdt. dated July 18, 2007
Reply to Office Action mailed on April 19, 2007
Customer No. 27752

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REMARKS

Response to Restriction Requirement

The Office Action has made final the requirement, under 35 USC §121, election of a single disclosed invention for prosecution on the merits. Pursuant to this requirement, Applicants hereby elect to prosecute the invention designated in the Office Action as Invention I. Claims 1-5 and 21-29 are drawn to this invention. This election is made with traverse.

Response to Double Patenting Rejection

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/152,924. In the interest of furthering prosecution Applicants are prepared to file a terminal disclaimer upon notice of allowable subject matter.

Claim Rejections under 35 USC §112

The Office Action states that Claims 1-5 and 21-29 are rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the Office Action states that the term "derivatives" in these claims renders the claims indefinite. Applicants have amended the claims to delete references to "derivatives". Therefore, Applicants respectfully request that all rejections under 35 USC §112, second paragraph be withdrawn.

Rejection Under 35 USC §102(e) Over U.S. Patent No. 6,589,514

Claims 1-5 are rejected under 35 USC §102(e) over U.S. Patent No. 6,589,514 (hereinafter "Jensen"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference." Verdegai Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP §2131 (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP §2131. The elements must be arranged as required by the claim. In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990). Appellants respectfully submit that the 35 U.S.C. §102(e) rejection is improper because the reference cited by the Examiner does not expressly or inherently teach each and every element set forth in the claims.

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The Office Action states that Jensen discloses compositions comprising hexamidine (0-1%) and retinyl palmitate (0-1%), a retinoid and carriers including water, seed oil, and vegetable oil. Applicants have amended the claims to remove retinoid from the list of skin care actives. The Office Action does not disclose a reference for any of the other actives claimed in the amended claims. Therefore, Jensen does not teach each and every element set forth in the claims. On this basis Applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 23, 26-29 Under 35 USC §103(a) Under U.S. Patent No. 6,589,514 in view of Flick and Gensler

Claims 23, 26-29 are rejected under 35 USC §103(a) over U.S. Patent No. 6,589,514 (hereinafter "Jensen") in view of Flick et. Al. (Cosmetic Additives - An Industrial Guide, Pages 647-648, 652; PTO-892) further in view of Gensler et. Al. (Nutrition and Cancer, 29(2), 157-162; PTO-892). This rejection is traversed.

Applicants assert that the Office Action has failed to establish a *prima facie* case of obviousness, as the Office Action has not stated a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements from the cited references. Additionally, each and every element of the claimed invention is not taught. As stated in the Office Action Jensen does not disclose a composition comprising B3 or panthenol in combination with hexamidine and a carrier. The Office Action cites Flick for disclosing panthenol in a skin care product, and Gensler as administering nicotinamide topically. The Office Action further states that it would have been obvious to a person skilled in the art to make a skin care composition comprising hexamidine, Vitamin B3, panthenol, tocopherol and a carrier because Jensen discloses skin care composition comprising tocopherol acetate, hexamidine and discloses panthenol in skin care compositions and Flick discloses panethenol and tocopherol acetate as commercial available cosmetic additives and Gensler discloses that topical application of niacinamide and tocopherol can contribute to inhibition of photimmunosuppression and photocarcinogenesis.

Applicants assert that the combination of these references is improper. The Court has stated "it will be necessary...to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by

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the patent at issue. To facilitate review, this analysis should be made explicit." *KSR Int'l Co. v. Teleflex*; 127 S.Ct. 1727, 1741 (2007), and United States Patent and Trademark Interoffice memo re: *Supreme Court decision on KSR Int'l Co. v. Teleflex, Inc.* (attached). The Gensler reference is evaluating whether nicotinamide protects against photoimmunosuppression and skin tumorigenesis induced by UVB irradiation. This reference discusses UVB irradiation leading to immunosuppression of the capacity to reject syngeneic, antigenic tumors. This reference does not disclose combining nicotinamide with other actives, rather it only discloses combining nicotinamide with the solvent acetone. Further, Jensen and Flick do not disclose the use of actives which protect against photoimmunosuppression and skin tumorigenesis. The Office Action fails to explicitly state why one skilled in the art would be motivated to combine the disclosure of a patent relating to skin repair serums with a reference relating to cosmetics available for industrial use (Flick) with a reference disclosing the use of nicotinamide in a study to evaluate photoimmunosuppression and skin tumorigenesis. Applicants assert that there is no reason why one skilled in the art would have combined the teaching of these references, in particular to result in a skin care compositions of the present invention.

Additionally, none of the references cited disclose a skin care composition comprising from about 0.01% to about 10% of a vitamin B₃ compound. The only nicotinamide containing composition disclosed in Gensler is 40 μ mol of nicotinamide and 200 μ mol of acetone. The other references cited do not disclose a vitamin B₃ compound.

Because there is no reason to combine the references and because the combination of references fails to teach or suggest all claim limitations, the Office Action has failed to establish a *prima facie* case of obviousness. Applicants therefore respectfully request that this rejection be withdrawn.

Rejection of Claims 21-24 Under 35 USC §103(a) Under U.S. Patent No. 6,589,514 in view of Gensler and further in view of Patent Application No. WO 00/67722.

Claims 21-24 are rejected under 35 USC §103(a) over U.S. Patent No. 6,589,514 (hereinafter "Jensen") in view of Gensler et. Al. (Nutrition and Cancer, 29(2), 157-162; PTO-892) and further in view of Patent Application No. WO 00/67722 (hereinafter "Mammone"). Applicants traverse this rejection and assert that the Office Action has failed to establish a *prima facie* case of obviousness, as there is no reason for one skilled in the art to combine the references and not all elements of the claimed invention are taught in the cited references.

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Applicants assert that the combination of these references is improper. The Gensler reference is evaluating whether nicotinamide protects against photoimmunosuppression and skin tumorigenesis induced by UVB irradiation. This reference does not disclose combining nicotinamide with other actives, rather Gensler only suggests combining nicotinamide with the solvent acetone. Nor does the Jensen or Mammone references disclose the use of actives which protect against photoimmunosuppression and photocarcinogenesis. The Office Action fails to explicitly state a reason why one skilled in the art would be motivated to combine the disclosure of a patent relating to skin repair serums with a patent relating to exfoliation and moisturization with a reference disclosing the use of nicotinamide in a study to evaluate photoimmunosuppression and skin tumorigenesis. Applicants assert that one skilled in the art would not have a reason to combine the teaching of these references, in particular to result in the skin care compositions of the present invention..

Additionally, none of the references cited disclose a skin care composition comprising from about 0.01% to about 10% of a vitamin B₃ compound. The only nicotinamide containing composition disclosed in Gensler is 40 μ mol of nicotinamide and 200 μ mol of acetone. The other references cited do not disclose a vitamin B₃ compound.

Because there is no reason to combine the references and because the combination of references fails to teach or suggest all claim limitations, the Office Action has failed to establish a *prima facie* case of obviousness. Applicants therefore respectfully request that this rejection be withdrawn.

Rejection of Claim 25 Under 35 USC §103(a) Under U.S. Patent No. 6,589,514 in view of US Patent Application No. 2003/0176366.

Claim 25 is rejected under 35 USC §103(a) over U.S. Patent No. 6,589,514 (hereinafter "Jensen") in view of US Patent Application No. 2003/0176366 (hereinafter "Castiel"). The Office Action states that the instant application is a CIP of 10/379,252 filed 3/04/2003. The Office Action further states that the original application fails to provide adequate support under 35 USC §112 for the instant new claim 25, since the original application did not disclose the particular composition comprising ascorbyl glucoside recited in claim 25. Applicants have amended Claim 25 to depend on Claim 23. Applicants assert that a *prima facie* case of obviousness has not been established, as not all elements of the claimed invention are disclosed by the cited references, and because one of ordinary skill in the art would not have a reason to

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combine these references. Applicants assert that none of the references cited by the Examiner disclose a skin care composition comprising from about 0.01% to about 10% of a vitamin B₃ compound. The only nicotinamide containing composition disclosed in Gensler is 40 μmol of nicotinamide and 200 μmol of acetone. The other references cited do not disclose a vitamin B₃ compound. Further, as stated above Applicants assert that one skilled in the art would not have a reason to combine the teaching of the cited references, in particular to result in a skin care composition.

Because there is no reason to combine the references and because the combination of references fails to teach or suggest all claim limitations, the Office Action has failed to establish a *prima facie* case of obviousness. Applicants therefore respectfully request that this rejection be withdrawn.

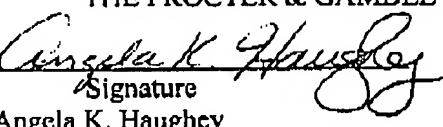
Conclusion

In light of the above amendments and remarks, it is requested that the Examiner reconsider and withdraw the rejections. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

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MEMORANDUM

DATE: May 3, 2007

TO: Technology Center Directors

FROM: *Margaret A. Focarino*
Margaret A. Focarino
Deputy Commissioner
for Patent OperationsSUBJECT: Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdf/04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

(1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

(2) The Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

(3) The Court rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. The Court specifically stated:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.